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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,334	10/07/2003	Tetsu Fukuda	03560.003371.	2683
5514 7590 08/19/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
SAWAGED, SARI S				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/679,334

**Applicant(s)**

FUKUDA ET AL.

**Examiner**

SARI SAWAGED

**Art Unit**

2623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 2, 6, 7, and 8 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 2, 6, 7, and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Bacso et al. (hereinafter referred to as Bacso) (US Pub No. 2002/0116510).**

**Claims 1, 2:**

Bacso discloses a receiving apparatus (receiver 30, Fig. 4) that comprises a plurality of receiving units (CPS, [0034]), where the receiving units receive communication data via the internet (see [0040] from an external device (server, [0081]) and broadcast data via a broadcast network (satellite, [0047]) from a broadcast station.

Bacso discloses that the receiver includes a plurality of decoders (plurality of CPS that each include a decoder, [0034]) for decoding the data received by the internet and the broadcast receiving units.

Bacso discloses that the receiving apparatus further includes a buffer memory ["buffer" in Figure 9, and "storage" in [0062]] for storing an event program (Advertisement "AD", see Figure 9) and an event message (AD trigger and DTMF, Fig. 9 and [0073]) so as to enable seamless switching between different content sources (see [0062]).

Bacso discloses that his receiving apparatus can switch between different content sources (and decoding methods, see [0034]) (therefore the receiving apparatus inherently has a control unit). Bacso further discloses that the decoding method executed by the decoder is switched to read and display from buffer memory an advertisement (event program) in response to a trigger (event message) indicating that an advertisement is to be displayed (see Fig. 9).

**Claim 6:**

Bacso discloses the receiving apparatus according to claim 1 as discussed previously.

Bacso discloses that in response to a trigger (event message indicating that a commercial is to begin) the receiving apparatus switches data reception from the current source to the target content source (see [0055]). Bacso also discloses that the receiver is capable of receiving content from a broadcast source and an internet source (see [0054]). When a viewer is receiving content over the internet and a trigger is received via the broadcast source, the receiver is capable of switching from the internet

source to the broadcast source based on the trigger and receive/display the content from the broadcast source (as shown if Fig. 9).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacso in view of Dunn et al. (hereinafter referred to as Dunn) (US Pat No. 5,721,829).**

**Claims 7, 8:**

Bacso discloses the receiving apparatus according to claim 1, as discussed previously.

Bacso discloses that the receiving apparatus can store content received (including data from the internet) by the receiving apparatus (and therefore inherently has a storage unit) (see [0053]).

Bacso further discloses that the receiving apparatus can switch from one content stream (channel) to another content stream (channel) for the duration of an AD, implying the receiving apparatus switches back to the original stream at the end of the

AD (therefore Bacso inherently has a trigger to indicate that a program/advertisement ends) (these streams can be from different sources such as the Internet or a broadcast station as disclosed in [0055]).

Bacso however doesn't disclose "recording information on the on the communication data of the program recorded in the recording unit".

Dunn, an inventor from the same or a similar field, discloses a receiving apparatus (STB, see Col. 6 line 58) wherein, if a user switches from a first channel to second channel (VOD and non-VOD channels, Col. 6 lines 16-17), identification information (program ID, Co. 6 line 57)) and a "pause point" (playback duration of the program) (Col. 6 line 59) of the data on the first channel is transmitted to and stored at the head-end. When the user switches back from the second channel to the first channel, the receiving apparatus receives the remaining data of the program from an external device ("media server", Col. 3 lines 64-66) based on the data of the program stored in the storage unit (SQL database 46 in the database server 44 located at the head-end 22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the receiving apparatus of Bacso to store identification information and playback duration of a streaming program so as to enable a viewer the flexibility to view other content without being penalized by missing a portion of a program that they rented.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARI SAWAGED whose telephone number is (571)270-5085. The examiner can normally be reached on Mon-Thurs, 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW KOENIG can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sari Sawaged/  
Examiner, Art Unit 2623

/Andrew Y Koenig/  
Supervisory Patent Examiner, Art Unit 2623